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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,844	11/16/2001	C. Frank Bennett	ISPH-0617	2097
26259	7590	06/24/2004	EXAMINER	
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			SCHULTZ, JAMES	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/001,844

Applicant(s)

BENNETT ET AL.

Examiner

J. Douglas Schultz, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,12 and 14 is/are rejected.
7) ☒ Claim(s) 4-10,13 and 15 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Status of Application/Amendment/Claims

1. Applicant's response filed April 12, 2004 has been considered. Rejections and/or objections not reiterated from the previous office action mailed January 22, 2004 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to claim Rejections - 35 USC § 112

3. The rejection of claims 1, 2, 4-10, and 12-20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, has been withdrawn in view of applicants amendment, which specifies that SEQ ID NO: 3 refers to the nucleic acid encoding SHH.
4. The rejection of claims 15-20 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for antisense-mediated inhibition of Sonic hedgehog (SHH, SEQ ID NO: 3) expression *in vitro*, does not reasonably provide enablement for antisense-mediated inhibition of SHH expression *in vivo*, or for methods of treating diseases associated with its expression *in vivo*, has been withdrawn in view of applicants cancellation of the instant claims.

Claim Rejections - 35 USC § 102

5. The rejection of claims 1, 2, 4, 5, 11, 12, 14, and 15 under 35 U.S.C. 102(b) as being anticipated by Sadler et al., has been withdrawn in view of applicants amendment to the claims, which now recite a target region on SHH that is not taught by Sadler.

6. The rejection of claims 1, 2, 4, 5, 11, 12, 14, and 15 under 35 U.S.C. 102(e) as being anticipated by Ingham et al. (U. S. Patent Number 6,165,747) has been withdrawn in view of applicants amendment to the claims, which now recite a target region on SHH that is not taught by Ingham.

Claim Rejections - 35 USC § 103

7. Claims 1, 2, and 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingham or Sadler et al. in view of Taylor et al. (Drug Disc. Today, 1999. 4(12)562-567) and Barracchini et al. (U. S. Patent Number 5,801,154), has been withdrawn in view of applicants amendment to the claims, which now recite a target region on SHH that is not taught by the combination of the cited prior art.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 and 103 that form the basis for the rejections under these sections made in this Office action:

A person shall be entitled to a patent unless --

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102(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

102(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

103(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 12, and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palm *et al.* (Brain Res. Mol. Brain Res. 2000. 78 (1-2), 192-195).

The claims of the above invention are drawn to antisense compounds 8 to 50 nucleotides in length that specifically hybridize with nucleobases 501 to 926 of SHH of SEQ ID NO: 3 and inhibit SHH expression.

The primer of Palm *et al.* possesses 100% identity with residues 756 to 782 of the instant application, and would thus specifically hybridize with the claimed target region of SHH of SEQ ID NO: 3. Although this reference does not specifically teach the function of inhibiting applicants' instant SEQ ID NO: 3 as claimed in the present application, the above-listed compound of the prior art meets all the structural limitations as set forth in the instant claims. Because the sequence is identical to applicant's claimed compound, in the absence of evidence to the contrary the compound of the prior art is thus considered to possess the functional limitations of specifically hybridizing with and inhibiting the expression of applicants' instant target of SEQ ID NO: 3. Support for this conclusion is drawn from MPEP 2112:

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Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim **but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection.** "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. 102/103 rejection is appropriate for these types of claims as well as for composition claims. *Emphasis supplied.*

In rejecting the claims of the above under 35 U.S.C. 102 and 103, a *prima facie* case has been established by the examiner whereby the burden of proof in showing that the claimed compounds are not anticipated by the compound of the prior art as stated lies with the applicant, as per MPEP 2112.01:

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

Thus, in the absence of evidence to the contrary, the antisense compounds of claims 1, 2, 12, and 14 of the instant application are considered anticipated and/or obvious as outlined above.

9. Claims 1, 2, 12, and 14 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Altaba *et al.* (U. S. Patent Number 6,238,876).

SEQ ID NO: 6 of Altaba *et al.* possesses 100% identity with residues 560 to 577 of the instant application, and would thus specifically hybridize with the claimed target region of SHH of SEQ ID NO: 3. Although this reference does not specifically teach the function of inhibiting applicants' instant SEQ ID NO: 3 as claimed in the present application, the above-listed

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compound of the prior art meets all the structural limitations as set forth in the instant claims.

Because the sequence is identical to applicant's claimed compound, in the absence of evidence to the contrary the compound of the prior art is thus considered to possess the functional limitations of specifically hybridizing with and inhibiting the expression of applicants' instant target of SEQ

ID NO: 3. Support for this conclusion is drawn from MPEP 2112:

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim **but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection.** "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. 102/103 rejection is appropriate for these types of claims as well as for composition claims. *Emphasis supplied.*

In rejecting the claims of the above under 35 U.S.C. 102 and 103, a *prima facie* case has been established by the examiner whereby the burden of proof in showing that the claimed compounds are not anticipated by the compound of the prior art as stated lies with the applicant, as per MPEP 2112.01:

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

Thus, in the absence of evidence to the contrary, the antisense compounds of claims 1, 2, 12, and 14 of the instant application are considered anticipated and/or obvious as outlined above.

Allowable Subject Matter

Claims 4-10, 13, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Douglas Schultz, Ph.D. whose telephone number is 571-272-0763. The examiner can normally be reached on 8:00-4:30 M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be

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reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

JD Schultz, PhD



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SUPERVISORY PATENT EXAMINER
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